



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,398	01/23/2001	Charles F. Spitz	0655/62341	2312

7590 07/05/2005

RICHARD F. JAWORSKI
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

STULBERGER, CAS P

ART UNIT	PAPER NUMBER
----------	--------------

2132

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,398

Applicant(s)

SPITZ, CHARLES F.

Examiner

Cas Stulberger

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: application, filed 01/23/2001; request for continued examination filed 04/11/2005.
2. Claims 1-39 are pending in the case. Claims 1, 15, 27, and 39 are independent claims.

Response to Amendment

3. Applicant argues that “the signing system is capable of receiving signature requests from a plurality of authorized users.” Forde discloses an invention which provides a computer-based method and system for applying a set of business signing rules for the processing of electronic documents (Forde: Abstract). This meets the limitation of “each signature request including a document to be signed.” Forde also discloses that the invention includes the design of a user interface which allows an administrator to create or modify signing and processing rules for multiple electronic documents and multiple signers at the same time (Forde: page 3, lines 15-20). This meets the limitation of receiving signature requests from a plurality of authorized users.”
4. Applicant argues “that each signature request includes a preexisting document to be signed.” This limitation is an inherent feature in Forde since it is impossible to sign a document that does not exist.
5. Applicant also argues that “the signing system signs the document using information unique to the signing system when it is determined by the signing system that the authorized user is authorized to have the document signed.” Forde discloses that the process of affixing a digital signature consists of using a private key to encrypt a document (Forde: page 12, lines 14-24). This meets the limitation of “the signing system signs the document using information unique to

the signing system when it is determined by the signing system that the authorized user is authorized to have the document signed.”

6. Applicant also argues that “the signing system parse the document to be signed and compares information obtained thereby to the access control rules stored in the database to determine whether the authorized user is authorized to have the document signed.” Forde discloses that a user enters information based on the quantity of a desired number of items, a description of the desired items, and a cost of the desired items (Forde: page 9, lines 3-12). The user then enters his smart card and the user is authorized. The values entered are then compared to the values in a table to make sure they are not exceeded (Forde: page 11, lines 9-21). This meets the limitations of “the signing system parse the document to be signed and compares information obtained thereby to the access control rules stored in the database to determine whether the authorized user is authorized to have the document signed.”

7. In view of the rejections and response to arguments above, the prior art rejections are maintained. The grounds of rejection as set forth in the previous office action is reproduced below.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5, 6, 10-17, 19, 20, 23-29, 31, 32, and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Application WO 00/57318 to Forde et al. in view of International Application WO 00/62220 to Brown et al.

In regards to claims 1-3, 15-17, 27-29, and 39, Forde discloses a computer-bases method of applying a set of digital business signing rules for the processing of electronic documents. The method verifies the identity of an authorized user using a predefined verification protocol. Then a set of privileges associated with said authorized user is determined (Forde: page 5, lines 7-11). This meets the limitation of “comparing information obtained thereby to the access control rules stored in said database to determine whether the authorized use is authorized to have the document signed.” Next the digital signature is attached to the electronic document (Forde: page 5, line 14). This meets the limitation of “the signing system signs the document using authentication information unique to the signing system.” Forde also discloses an exemplary list of authorized users and their associated privileges in Table 1 (Forde: Table1; page 10, line 2). This meets the limitation of “a database holding access control rules that identify documents authorized users are allowed to have electronically signed.” However Forde doesn’t teach parsing the document.

Brown discloses a parser which parses the document to identify the portion to be signed by the signer (Brown: page 12, last paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of processing electronic documents as taught by Forde with the method of parsing a document as taught by Brown in order to identify the to-be-signed portion of the document (Brown: page 13, second paragraph).

In regards to claims 5, 19, and 31, Forde discloses that the digital signature is an encrypted hash. The encryption is based on a private encryption key corresponding to the authorized user. The private key is complementary to a public decryption key corresponding to the authorized user (Forde: page 23, claim 33). This meets the limitations of “wherein said user authentication information comprises a digital certificate, with corresponding public and private keys.”

In regards to claims 6, 20, and 32, Forde does not disclose the digital certificate comprising an X-509 certificate. Brown discloses that the digital certificate used is the ANSI X.509 standard (Brown: page 29, last line of the first paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of using the digital certificate as taught by Forde with the X-509 digital certificate as taught by Brown because the X-509 digital certificate is the ANSI standard (Brown: page 29, last line of the first paragraph).

In regards to claim 10, Forde discloses that F. Smith is given request privilege to a maximum cost of \$5000 (Forde: page 11, lines 19-20). If F. Smith attempts to fill in an amount in the cost field of the document greater than \$5000 the received document data would be rejected (Forde: page 12, lines 5-7). This meets the limitation of “a document validation server capable of receiving document validation requests from a user requesting a signed document to be validated and determining whether the signed document is valid in response to the request.”

In regards to claims 11, 12, 23, 24, 35 and 36, Forde discloses that a user, in this case the issuer, L. Carter, is verified. L. Carter inserts his smart card in to the purchasing intelligent device. L. Carter's smart card matches an authorized user from the user list and the purchasing intelligent device is made available by the server for use by L. Carter. His privileges are determined. L. Carter opens his electronic mailbox later and finds the electronic purchase order in his in-box (Forde: page 14, lines 19-29). This meets the limitations of "wherein after the document validation server signs the document, the signed document is electronically forwarded to the user so that the user can forward the signed document to the recipient."

In regards to claims 13, 14, 25, 26, 37, and 38, Forde discloses that after the digital signature is affixed to the purchase order using a private encryption key, the completed order is transferred to the appropriate vending server connected by network (Forde: page 15, lines 25-31). The vending user using the vending intelligent device can then open an electronic mailbox and find the completed purchase order (Forde: page 16, lines 1-10). This meets the limitations of "wherein after the document is signed, the signed document is automatically electronically forwarded or emailed to a recipient."

10. Claims 4, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forde et al. in view of Brown et al. as applied to claims 1-3, 5, 6, 10-17, 19, 20, 23-29, 31, 32, and 35-39 above, and further in view of U.S. Patent Application Publication No. 2002/0078140 A1 to Kelly et al.

Forde however does not teach that the document is not parsed if the user is not authenticated. Kelly teaches that the method may also include the step of authenticating the user before parsing the file (Kelly: page 2, paragraph 0027).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the computer based method and system for applying a set of business signing rules for the processing of electronic documents as disclosed by Forde with the method of authenticating the user before parsing the document as disclosed by Kelly in order to ensure that the page is not edited by an unauthorized person (Kelly: page 2, paragraph 0027).

11. Claims 7-9, 21, 22, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forde et al in view of Brown et al, and in further view of Kelly et al. as applied to claims 1-3, 5, 6, 10-17, 19, 20, 23-29, 31, 32, and 35-39 above, and further in view of U.S. Patent No. 5,742,769 to Lee et al.

Forde however does not disclose using the user's email address for authentication by comparing it to the email address stored in the database. Lee discloses that the processor provides an input screen that requests the user's email address and password. These items of user-entered information are provided to a security application that authenticates the user-entered information based on the information stored in subscriber database (Lee: column 5, lines 10-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the computer based method and system for applying a set of business signing rules for the processing of electronic documents as disclosed by Forde with the method of authentication using the comparison of user-entered information with that stored in a

database as disclosed by Lee in order to provide users with additional services that are preferably not otherwise available to a user who accesses the web site without authentication (Lee: column 4, lines 59-62).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,314,425 B1 to Serbinis et al.

U.S. Patent No. 5,787,175 to Carter

U.S. Patent No. 5,315,504 to Lemble

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2132


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cas Stulberger whose telephone number is (571) 272-3810. The examiner can normally be reached on Monday - Friday, 9:00A.M. - 6:00P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CS

CS


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100